

## **REMARKS/ARGUMENTS**

In the May 30, 2008 Office Action, the Examiner rejected claims 1-11 pending in the application. This response amends independent claim 1 for further consideration. After entry of the foregoing amendments, claims 1-11 (1 independent claim; 11 total claims) remain pending in the application. Reconsideration is respectfully requested.

The Examiner first objected to claims 1-11 due to an informality that the claims were currently recited as (c1), (c2), etc. In particular, the Examiner stated that the claims did not clearly recite the claim number. In response to the examiner's rejection, Applicant has renumbered the claims.

Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner states that the term "small" in claim 1 is a relative term which renders the claim indefinite. In response to the Examiner's rejection, Applicant has amended independent claim 1 to define the protuberances as being "protuberances smaller than said plug members". In addition, the Examiner states that claim 1 recites "the plugs" and that there is a lack of antecedent basis for "the plugs". In response to the Examiner's rejection, Applicant has amended "the plugs" to read "the plug members".

Claims 1-3 and 5-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Carl, U.S. Patent No. 5,497,670 (hereafter "Carl"). In particular, the Examiner states that Carl teaches an apparatus for transferring pipette tips comprising a transfer plate 16 having a plurality of plug members (cylinders 26) extending therethrough. The Examiner further states that the plug members engage the pipette tips 20 disposed in a frame 18 and that Carl teaches that the frame 18 is assembled and interlocked with the transfer plate via shafts 12, 14. The Examiner also states that the frame 18 has openings (see Fig. 5) for inserting the plugs 26 therethrough to engage the pipette tips 20. In addition, the Examiner further states that the openings hold the pipette tips 20 and the frame 18, shown in greater detail in Fig. 5, includes a plurality of "small" protuberances 22, 28 extending into the openings.

Further, with respect to claim 2, the Examiner states that the plug members 26 are arranged in parallel lines separated by elongated slots (openings in the plate 16) as shown in Figs. 4 and 7. In addition, with regard to claim 3, the Examiner states that the openings in the frame 18 of Carl comprise "elongated" slots separated by "elongated" rails. The Examiner

further states that the limitation “elongated slots” reads on the openings in the frame in which the pipette tips are disposed as shown in Fig. 5. In addition, the Examiner states that the limitation “elongated rails” reads on the area between the openings in which the tips are disposed, shown in Fig. 5 with hatches lines. The Examiner also states that the dimensions of the openings or slots are not defined in the claim or the specification and that therefore the openings of Carl and the frame and the area in-between the openings can be considered “elongated slots” to one of ordinary skill.

With regard to claim 5, the Examiner states that the plug members 26 are hollow to accept the piston 32 therein as shown in Fig. 6. The Examiner further states that claim 6 functionally describes the operation of the apparatus and that a recitation with respect to the manner in which a claimed apparatus is intended to be operated fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all of the structural limitations of the claim. Nevertheless, the Examiner states that Carl does in fact teach vertically sliding the transfer plate 16 relative to the frame 18 as in Figs. 4 and 7. The Examiner also states that the transfer plate 16 can be slid downward to a “retained and a released position” wherein the plugs 26 have pipette tips positioned thereon as shown in Fig. 4. Further, with regard to claim 7, the Examiner states that the protuberances 20, 28 are in contact with the pipette tips positioned over the plugs when the apparatus is in the retained position as shown in Fig. 4. Further, with regard to claim 8, the Examiner states that the protuberances 22, 28 are located between the plugs 26 when the apparatus in a released position (i.e., when the transfer plate 16 is moved vertically downward so that the plugs engage the pipette tips). Also, with regard to claim 9, the Examiner states that the transfer plate 16 further comprises at least one “tab member” for sliding the frame relative to the transfer plate. In particular, the Examiner states that the shaft 12 of Carl reads on the “tab member” since it allows the frame 18 to slide relative to the transfer plate 16. The Examiner contends that nothing in Applicant’s claim structurally distinguishes the tab member from the shaft of Carl.

With regard to claim 10, the Examiner states that the transfer plate 16 and the frame 18 are generally rectangular in shape as shown in Fig. 3. Finally, with regard to claim 11, the Examiner states that the transfer plate 16 and the frame 18 are removable from one another (i.e., separated when the transfer plate is slid upward along shafts). Applicant respectfully traverses this rejection.

Applicant's independent claim 1 requires a transfer plate having a plurality of plug members for engaging pipette tips. The Examiner states that Carl teaches an apparatus for transferring pipette tips comprising a transfer plate 16 having a plurality of plug members (cylinders 26) extending therethrough. Applicant's independent claim 1 requires that the transfer plate have (i.e. include) a plurality of plug members as part of the transfer plate. Pipette tip plate holder 16 in Carl does not include plug members or cylinders (See Figures 1-7) and instead includes openings through which cylinders 26 are moved. In addition, Applicant's independent claim 1 requires a frame assembled and interlocked with the transfer plate where the frame has openings contained therein and a plurality of small protuberances smaller than the plug members extending into the openings. Although frame 18 in Carl does have openings contained therein, frame 18 does not have protuberances smaller than the plug members (or cylinders) extending into the openings. Instead, Carl discloses O-rings 22 with precision washers 28 for each disposable pipette tip in pipette tip plate 18 (See col. 3, lines 11-13).

Therefore, in that Carl fails to disclose each and every element of Applicant's independent claim 1, Carl cannot anticipate Applicant's claims. Accordingly, Applicant respectfully requests the Examiner's withdrawal of her 35 U.S.C. Sec. 102 rejection.


Claim 4 also stands rejected under 35 U.S.C. §103(a) as being unpatentable over Carl. In particular, the Examiner states that it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the transfer plate and frame from a moldable plastic since the skilled artisan would be able to determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature. Applicant respectfully traverses this rejection.

As previously set forth above in Applicant's arguments, Carl fails to disclose each and every element of Applicant's independent claim 1. Accordingly, Applicant's dependent claim 4 could not have been obvious to one of ordinary skill in the art. Applicant's above arguments are herein incorporated by reference in their entirety with respect to the examiner's 35 U.S.C. §103(a) rejection.

In view of the foregoing, Applicant respectfully submits that all of the pending claims fully comply with 35 U.S.C. §112 and are allowable over the prior art of record. Reconsideration of the application and allowance of all pending claims is earnestly solicited. Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Applicants authorize and respectfully request that any fees due be charged to Deposit Account No. 19-2814. **This statement does NOT authorize charge of the issue fee.**

Dated: December 1, 2008

Respectfully submitted,

By   
Laura J. Zeman  
Reg. No. 36,078

**SNELL & WILMER L.L.P.**  
One Arizona Center  
400 East Van Buren  
Phoenix, Arizona 85004-2202  
Telephone: (602) 382-6377  
Facsimile: (602) 382-6070